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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/627,270 04/04/96 TOJO

EXAMINER

C2M1/0904

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ART UNIT	PAPER NUMBER
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3206
DATE MAILED:

09/04/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 14-16, 19, 20 and 22-36 are pending in the application.
- Of the above, claim(s) 14-16, 19 and 34-37 is/are withdrawn from consideration.
- ☐ Claim(s) 22-33 is/are allowed.
- ☒ Claim(s) 14-16, 19, 20 and 22-36 is/are rejected.
- ☐ Claim(s) 14-16, 19, 20 and 22-36 is/are objected to.
- ☒ 14-16, 19, 20 and 22-36 are subject to restriction or election requirement.

Drawings

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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1. The restriction requirement of paper #3 is hereby repeated and made FINAL.

2. Claims 14-16, 19 and 34-36 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

In traversing the restriction requirement, Applicant argues that the claims are drawn to a single inventive concept, i.e. an efficient method of forming a high quality strippable paint film on a large-sized product. However, the method claims also recite an "assembly" step. Accordingly, the method claims are not drawn to the same inventive concept as the apparatus claims. Thus, all pending claims are not drawn to the same single inventive concept.

Also, because the search for the method claims would be different than that for the apparatus claims, a serious burden would be placed on the examiner if he were to examine both Groups of inventions.

Finally, Applicant argues that claims 35 and 36 are linking claims. However, these claims do not recite any "means" for assembly, but rather merely recite a "booth" in which assembly is intended to occur. Thus, claims 35 and 36 are not linking claims.

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For the above reasons, the restriction requirement remains proper.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 20, 22, 24, 25, 26, 27, 28, 29, 30, 31, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art as described in the specification in view of Tomioka et al.

The "Description of the Related Art" on pages 1-4 of the specification discloses as prior art a method for forming a protective film on a large paint-finished product, comprising the steps of:

painting an automobile, thereby providing a paint-finished;
assembling the automobile by mounting an engine and
functional parts thereto; and

coating strippable paint onto a painted surface of the paint
finished automobile (page 2, line 15 through page 3, line 10).

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This prior art method fails to literally disclose that the automobile is assembled after it has been painted. Tomioka et al. teaches assembling an automobile, by mounting an engine and functional parts thereto, after painting the automobile (See column 1, lines 30-35). Accordingly, in view of Tomioka et al. one having ordinary skill in the art would have found it obvious to assemble the automobile after painting it, if the prior art method does not already do so.

And, if it is determined that Applicant's admitted prior art does not disclose coating strippable paint onto a painted automobile, then in view of the prior art teaching at page 2, lines 7-8 of the specification, one would have found it obvious to do so in order to realize the benefits that a strippable paint exhibits relative to the rust preventive wax discussed on page 1, lines 17-21 of the specification.

Regarding claims 22 and 28 Applicant's admitted prior art at page 2, lines 21-22 of the specification, discloses assembling the automobile prior to applying the strippable paint. Regardless, when the strippable paint is applied relative to the assembling step is deemed to be a matter of design choice, because such sequence of steps per se solves no stated problem.

The subject matter of claims 24 and 26 would have been obvious because it is well known to inspect assembled and painted product for quality control purposes.

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The subject matter of claims 25 and 29 would have been obvious in view of Tomioka et al., because Tomioka et al. teaches performing an assembling operation as a final step.

The subject matter of claim 27 is considered to be disclosed by Applicant's admitted prior art, because as the strippable paint thereof begins to dry it is considered to be preliminarily dried, and as this strippable paint finally dries it is considered to be non-preliminarily dried.

Regarding claims 30-33, the exact drying method utilized are deemed to be matters of design choice, because such method per se solve no stated problem. And, the stabilizing step of claims 31 and 32 is considered to be disclosed by Applicant's admitted prior art. If it is not, then this stabilizing step is deemed to be a matter of design choice, because such stabilizing step per se solves no stated problem.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Tomioka et al. as applied to claim 20 above, and further in view of Verdick.

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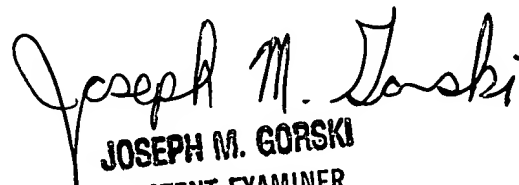
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Verdick teaches fitting a protective cover to a member in order to protect this member during an assembly operation. Accordingly, in view of Verdick one having ordinary skill in the art would have found it obvious to modify Applicant's admitted prior art method by fitting a protective cover to the automobile in order to protect the automobile during assembling operations.

6. Any inquiry concerning this communication should be directed to Joseph Gorski at telephone number (703) 308-1805.

GORSKI/D.Z.R.

AUGUST 27, 1997


JOSEPH M. GORSKI
PATENT EXAMINER
GROUP 320 - ART UNIT 326